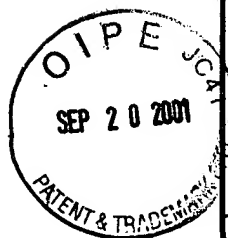


Please type a plus sign (+) inside the box → ☐

PTO/SB/21 (10-96)
Approved for use through 10/31/99. OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/294,663
Filing Date	04/19/99
First Named Inventor	Granados et al
Group Art Unit	1638
Examiner Name	Ibrahim, M.
Attorney Docket Number	BTI-39CIP

Total Number of Pages in This Submission **10**

TECH CENTER 1600/2300

SEP 25 2001

RECEIVED

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Checklist and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Brown & Michaels, PC
Signature	<i>Thomas T. Aquella</i>
Date	9/17/01

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: 7099 32200007 47583978

Typed or printed name	Judy H. Barron	Date	9-17-01
Signature	<i>Judy H. Barron</i>		

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

September 17, 2001

TECH CENTER 1600-2900

SEP 25 2001

RECEIVED

In re Application of: Granados *et al.*
Serial No. 09/294,663
Filed: April 19, 1999
For: A NOVEL INVERTEBRATE INTESTINAL MUCIN cDNA AND
RELATED PRODUCTS AND METHODS
Examiner: Ibrahim, M.
Art Unit: 1638
Attorney Docket No.: BTI-39-CIP

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

HONORABLE COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

This application is before the Honorable Board of Appeals on appeal from the Final Rejection by the Examiner dated December 12, 2000, wherein claims 1, 6 and 9 were finally rejected.

Under 37 C.F.R. § 1.193(b)(1), Appellant may file a reply brief directed to new points of argument raised in the examiner's answer, within two months of the date of such Answer. Appellant hereby submits its Reply Brief, in response to the new points of argument raised in the examiner's Answer, which was mailed on July 17, 2001.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the U.S. Postal Service as Certified Mail No: 7699 3220 0007 4758 3978 with a return receipt requested, in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on 9-17-01


Judy H. Barron

(1)

NEW POINTS OF ARGUMENT RAISED IN EXAMINER'S ANSWER

In the Examiner's Answer, the Examiner argues that "The first step in obtaining a gene encoding a protein is to purify the protein, sequence the protein, and then design a nucleic acid hybridization probes (sic) which would encode part or all of the isolated, sequenced protein." Examiner's Answer, page 4, lines 16-19. The Examiner did not raise this argument in the Final Rejection, mailed December 12, 2000; this argument by the Examiner is raised for the first time in the Examiner's Answer.

Further, in regard to the ample data in Appellant's application, which provide guidance to one of ordinary skill in the art seeking to identify other genes that encode IIM proteins (including undiscovered genes) by teaching the use of the IIM antibody as a screening tool, the Examiner argues for the first time that "the crude protein preparations cast doubt on any data obtained by reacting antibodies thereto. Furthermore, the lack of purified protein for any non-*T. ni*-derived IIM protein would prohibit even the initial stages of gene isolation, as discussed above." Examiner's Answer, first complete paragraph on page 5. The Examiner did not raise these arguments in the Final Rejection, mailed December 12, 2000; these arguments by the Examiner are raised for the first time in the Examiner's Answer.

(2)

TRAVERSAL OF EXAMINER'S NEW POINTS OF ARGUMENT

The Examiner's assertion that "The first step in obtaining a gene encoding a protein is to purify the protein, sequence the protein, and then design a nucleic acid hybridization probes (sic) which would encode part or all of the isolated, sequenced protein" is factually incorrect. Contrary to the Examiner's assertion, it was well known in the art at the time of the present invention that one of ordinary skill can clone a gene without purifying the protein, sequencing the protein, or designing any nucleic acid hybridization probes whatsoever. See, *e.g.*, Sambrook, J., Fritsch, E.F. and Maniatis, T. (1989) *Molecular Cloning: A Laboratory Manual*, Cold Spring Harbor Laboratory Press, Cold Spring Harbor, NY, wherein it is taught that one can clone a gene by screening an expression library using an antibody, without purifying the protein, sequencing the protein, or designing any nucleic acid hybridization

probes. Indeed, Appellant cloned the *T. ni* IIM cDNAs disclosed in the present application by screening an expression library with the IIM antibody, according to methods that were well known in the art at the time of invention, and without any need for purifying the protein, sequencing the protein, or designing any nucleic acid hybridization probe whatsoever. The IIM antibody similarly could be used by one of ordinary skill in the art to identify and clone other cDNAs that encode IIM proteins, including undiscovered genes, without any need for purifying the protein, sequencing the protein, or designing any nucleic acid hybridization probe.

The Examiner's assertion that "the crude protein preparations cast doubt on any data obtained by reacting antibodies thereto. Furthermore, the lack of purified protein for any non-*T. ni*-derived IIM protein would prohibit even the initial stages of gene isolation, as discussed above" is not supported by any authority. Appellant traverses the Examiner's factual assertion that any "doubt" whatsoever reasonably could be cast upon Appellant's supporting data in the application, and in particular, data pertaining to the specificity of the IIM antibody. Indeed, there is no evidence of record casting any doubt whatsoever on Appellant's data, and, more particularly, there is no evidence that Appellant's IIM antibody is not specific for IIM protein. Thus, the Examiner's implication that the validity of Appellant's data is "doubtful" is traversed. Furthermore, the Examiner's assertion that "the lack of purified protein for any non-*T. ni*-derived IIM protein would prohibit even the initial stages of gene isolation" is traversed as being factually incorrect, as noted above.

Respectfully submitted:

By: Thomas T. Aquilla
Thomas T. Aquilla, Reg. No. 43,473, Attorney for Appellant
Brown & Michaels, P.C.
400 M&T Bank Building
118 North Tioga Street
Ithaca, NY 14850
Telephone: (607) 256-2000
Fax: (607) 256-3628
September 17, 2001